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TOWNSEND & TOWNSEND

NO. 4703 P. 3

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Attorney Docket No.: 020552-007100US  
Client Ref. No.: 1057

TOWNSEND and TOWNSEND and CREW LLP

By: 

Tara N. Darnoff

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Malik, et al.

Application No.: 09/927,597

Filed: August 10, 2001

For: HUMAN SMOOTH MUSCLE  
MYOSIN HEAVY CHAIN

Customer No.: 20350

Confirmation No.:

Examiner: David J. Steadman, Ph.D.

Technology Center/Art Unit: 1652

RESPONSE TO RESTRICTION  
REQUIREMENT

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This paper is filed in response to the Restriction Requirement mailed July 3, 2003. The original deadline for responding was August 3, 2003. Because this date fell on a Sunday, the deadline is extended until August 4, 2003. Accordingly, this response is timely filed.

In response to the Restriction Requirement, Applicants elect with traverse to prosecute the claims in Group III (i.e., claims 8-10, drawn to polypeptides having at least 90% amino acid sequence identity to SEQ ID NOs:2, 6, 8, 10, 12, and 14).

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The Office takes the position that claims 8-10 should be restricted into two groups (Groups III and IV) because SEQ ID NOs:2 and 4 are different and structurally distinct. In response it is submitted that claims 8-10 should not be restricted into two groups for at least two reasons. First, claims cannot be restricted without a showing by the Office that a search and examination of the claims on the merits would constitute an undue burden on the Office, even when the claims are directed to independent and distinct inventions (MPEP 803.01). While the Office appears to consider the amino acid sequences listed in SEQ ID NOs:2 and 4 as independent and distinct proteins, the proteins are in fact similar. SEQ ID NO:2 is the amino acid sequence for a protein encoded by SEQ ID NO:1, which includes exons 1-43. SEQ ID NO:4 is the amino acid sequence for a protein encoded by SEQ ID NO:3, which is that same as SEQ ID NO:1, except that it lacks the sequence for exon 42 (see, e.g., page 7, lines 9-14). Because SEQ ID NOs:2 and 4 share much of the same sequence, it would not be unduly burdensome on the Office to examine both sequences together.

Second, MPEP 803.04 states that the Office's policy is to consider 10 nucleotide or corresponding amino acid sequences, even if the sequences are independent and distinct. Here, SEQ ID NOs:2 and 4 have similar sequences and less than 10 specific sequences are listed in the claims. So to be consistent with the policy set forth in MPEP 803.04 the Office should not restrict SEQ ID NOs:2 and 4 into separate groups.

So for both of these reasons, it is requested that the Office withdraw the restriction requirement with respect to Groups III and IV.

It is further requested that the screening claims that have been restricted into Groups V and VI be rejoined once claims from Groups III and IV respectively are found allowable. MPEP 821.04 provides that if product claims are found allowable that applicants are entitled to rejoinder of process claims that depend from or otherwise include the limitations of the allowable product claim. As the Examiner acknowledges in paragraph 11, the product claims in Groups III and IV and the method claims of Groups V and VI respectively are related as product and method of use. So it is requested that the method claims of at least Group V be rejoined with the product claims of Group III should a claim in Group III be held allowable. If

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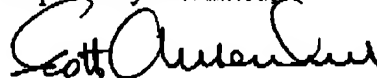
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the product claims from Group IV are also examined as requested above, then it is further requested that the corresponding process claims of Group VI be rejoined once a claim from Group IV is found allowable.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



Scott L. Ausenhus  
Reg. No. 42,271

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, 8<sup>th</sup> Floor  
San Francisco, California 94111-3834  
Tel: 303-571-4000  
Fax: 303-571-4321  
Attachments  
SLA:tnd  
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